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PATENT APPLICATION

Inventor(s): Quintin T. Phillips et al.

ATTORNEY DOCKET NO. **10006507-1**

Confirmation No.: 4805

Application No.: 09/932,237

Examiner: John W. Van Bramer

Filing Date: August 16, 2001

Group Art Unit: 3622

Title: Articles of Manufactures and Marketing Methods

Mail Stop Amendment
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☐ Response/Amendment
☐ New fee as calculated below
☐ No additional fee
☒ Other Reply Brief

- ☐ Petition to extend time to respond
☐ Supplemental Declaration

Fee\$

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$450	<input type="checkbox"/> 3rd Month \$1020	<input type="checkbox"/> 4th Month \$1590		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.18 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

☐ A duplicate copy of this transmittal letter is enclosed.

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Rev 10/06a(TransAndFax)

Respectfully submitted,

Quintin T. Phillips et al.

By 

James D. Shaurette

Attorney/Agent for Applicant(s)

Reg No. : 39,833

Date : 11/13/07

Telephone : 509/824-4276

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Filing Date..... August 16, 2001
Inventor..... Quintin T. Phillips et al.
Assignee..... Hewlett-Packard Development Company, L.P.
Group Art Unit 3622
Examiner.....John W. Van Bramer
Attorney's Docket No..... PDNO. 10006507-1
Confirmation No..... 4805
Title:Article of Manufacture and Marketing Methods

REPLY BRIEF

To: Mail Stop Appeal Brief-Patents
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

From: James D. Shaurette (Tel. 509-624-4276; Fax 509-838-3424)
Wells, St. John, P.S.
601 W. First Avenue, Suite 1300
Spokane, WA 99201-3817

Appellant respectfully asserts the rejections set forth in the Office Action dated December 12, 2006 (hereinafter "Office Action" or "Action") are deficient for the reasons set forth in the Brief of Appellant (hereinafter "Brief") and the reasons herein. Appellant respectfully requests reversal of the rejections of the claims.

Argument A - The 102 rejection of claims 1-7 and 21 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 1 recites *monitoring an association of a consumable with an image forming device and enabling communication of the marketing message to the image forming device user responsive to the monitoring*. Appellants respectfully submit that the various different teachings of Shambori relied upon by the Office fail to

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teach the claimed monitoring and enabling responsive to the monitoring as specifically claimed.

At pages 12+ of the Examiner's Answer (hereinafter "Answer"), the Office relies upon two different operations of Shambori in support of the rejection. In particular, the Office relies upon the first operations of Shambori teaching monitoring of an amount of consumables and ordering consumables responsive to the consumables being low per paragraph 0044. Furthermore, the Office relies upon the second operations of Shambori teaching determining whether the paper is correct paper and whether a printed product has been printed normally after the product has been printed per paragraph 0047. However, both of the operations of Shambori (and the remaining teachings of Shambori) fail to teach or suggest positively recited limitations of the claims as set forth below.

Referring to the first operations of Shambori (ordering consumables when such are depleted per paragraph 0044 of Shambori), Applicants respectfully submit that such operations fail to teach the claimed monitoring and enabling the communication responsive to the monitoring. In particular, paragraph 0044 teaches checking a remaining amount of consumable and automatically placing an order so as to avoid lack of consumable items. The ordering of consumables fails to teach the enabling communication of the marketing message as claimed. In particular, the generic replenishment of consumables by ordering fails to mention or disclose any communication or marketing message but merely generically assures that enough consumables are on hand void of any reference to enabling communication of a marketing message.

Appellants respectfully assert that the generic ordering of consumable operations of Shambori may not be fairly interpreted to teach the claimed combination of monitoring and enabling communication of the marketing message recited in claim 1.

Referring to the second operations of Shambori including verifying whether the printed paper is correct paper and whether a page printed normally, Appellants respectfully submit that such teachings may not be fairly interpreted to teach the claimed monitoring and the enabling responsive to the monitoring as claimed. Appellants respectfully submit that *monitoring of the printed output* per paragraph 0047 cannot be properly interpreted as teaching monitoring the association of the

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consumable with the image forming device as claimed. The outputted product of paragraph 0047 has already been printed and fails to teach or suggest association of the consumable with the image forming device let alone the claimed monitoring of the associating. Appellants respectfully submit that the monitoring of normalcy of the printed output and that correct paper was used to print the output per paragraph 0047 of Shambori fails to teach or suggest the claimed monitoring of the association of the consumable with the image forming device as claimed.

However, even if monitoring of normalcy of a printed page and that correct paper was used to print the output per paragraph 0047 is found to teach the claimed monitoring, Appellants respectfully submit that Shambori fails to teach enabling communication of the marketing message responsive to such monitoring of the printed output. In particular, the printed output has already been printed when the monitoring of paragraph 0047 occurs and the monitoring of the already printed material fails to teach or suggest the limitations of claim 1 reciting code configured to cause the processing circuitry to perform the step of enabling communication of the marketing message responsive to the monitoring. The monitoring of Shambori to determine whether the printing was correct *occurs after the advertisement communication of Shambori has already been enabled and performed.*

Appellants respectfully assert that the monitoring of printed output of Shambori may not be fairly interpreted to teach the claimed combination of monitoring and enabling recited in claim 1.

Appellants traverse the Office's recitation of the teachings of Shambori provided in the second and third to last sentences of page 14 of the Examiner's Answer. In particular, paragraphs 0041, 0042, 0044 of Shambori fail to teach or suggest printing the advertisement responsive to monitoring a level of consumables as alleged by the Office. To the contrary of the interpretation of the Office, Shambori teaches at paragraph 0044 reordering expended consumables after monitoring a level of consumables while paragraphs 0041 and 0042 are void of referring to a level of consumables, monitoring a level of consumables or printing responsive to the monitoring. These teachings of Shambori fail to teach or suggest printing an advertisement responsive to the monitoring of the level of consumables as alleged by the Office.

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Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument B – The 102 rejection of claims 8-19 and 22-24 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Independent claim 8 recites providing a consumable which is both: 1) usable to form hard images; and 2) usable *to enable a marketing function* with respect to image forming device users. The Office in the final Office Action merely identified paragraph 0040 as teaching the claimed providing and failed to provide any explanation as to how the paragraph 0040 and the generic reference to Fig. 1 therein is considered to teach the claimed providing limitations cited in claim 1. Now, at page 15 of the Answer, the Office merely states that the referenced paragraph is “self-explanatory.” However, the Office has failed to provide any explanation as to how the paragraph 0040 and Fig. 1 of Shambori are considered to teach the claimed providing the *consumable to form hard images and additionally to enable the marketing function*. The providing of claim 1 recites two limitations of the consumable being usable to form hard images and also to enable the marketing function. Claim 1 does not recite providing the consumable usable to form hard images including a marketing function but to the contrary explicitly claims *providing the consumable usable to form hard images and usable to enable a marketing function*. The Office has failed to point to any teaching in Shambori of any other function of the consumable of Shambori beyond merely printing on paper. However, claim 8 specifically requires the *providing the consumable usable to form hard image and usable to enable a marketing function*. Applicants respectfully submit that the reliance upon the consumable of Shambori is improper and the single function of printing on paper of Shambori has been relied upon as teaching two disparate limitations of the consumable usable to form hard images and useable to enable a marketing function. The Office has pointed to no marketing function different than the printing of images and the printing of images fails to teach the

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specifically claimed providing of the consumable usable to form hard images in addition to being usable to enable a marketing function as specifically claimed. The mere presence of a consumable to form hard images fails to teach the claimed limitations of the claimed consumable to form hard images and additionally to enable the marketing function as claimed. The generic identification of the components of Fig. 1 set forth in paragraph 0040 fail to teach or suggest the claimed providing of the consumable usable to enable a marketing function in addition to being useable to form hard images as specifically claimed. Appellants respectfully submit that the 102 rejection of the claims is improper for at least this reason.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument C – The 102 rejection of claims 20 and 25 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 20 recites *two positive claim limitations* with respect to the consumable including providing a consumable *usable in a printer to print hard images* and *usable to enable communication of a marketing message*. The Office has failed to identify any use of the consumable of Shambori apart from printing of hard images. Appellants respectfully submit that Shambori teaches printing the advertisement using the consumable which fails to teach or suggest providing the consumable *usable* to print hard images and additionally usable to enable communication of the marketing message with respect to printer users (which is in addition to being useable to print hard images) as positively recited in claim 20. Appellants respectfully submit that it is improper to rely upon one specific limitation of printing upon paper in Shambori to teach the claimed plural limitations of the consumable being usable to print hard images and additionally being useable to enable communication of the marketing message. Appellants respectfully submit that the 102 rejection is improper for at least this reason.

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Claim 20 also recites *detecting a triggering event and initiating communication of the marketing message responsive to the detecting*. At page 18 of the Action, the Office relies upon the teachings of paragraph 0075 as teaching two triggering events. However, the acts of checking the paper to be used and whether printing occurred normally occur *after the communication of the marketing message has already been initiated*. In particular, the second sentence of paragraph 0075 provides that the paper and output are checked after the printer has received the advertisement. Paragraph 0075 discussing Fig. 14 is clear that Fig. 14 is a sequence of the printing operation in step S30 and step S30 is performed *after the user indicates a wish to print the advertisement* as clearly discussed in paragraph 0067 of Shambori. Accordingly, *communication of the marketing message has already been initiated per paragraph 0067 by the user specifying printing of the advertisement before the alleged triggering operations of paragraph 0075 are performed and which fails to teach or suggest initiating communication of the marketing message responsive to the detecting the triggering event* as defined in claim 20.

Finally, the Office identifies the checking of the printed number of pages with reference to paragraph 0073 as teaching detecting a triggering event. However, Shambori is void of teaching that *communication of the marketing message is initiated responsive to the checking of the printed number of pages* with respect to a predetermined number. To the contrary, Shambori merely teaches that printing may be prevented if the number of printed pages is excessive. Shambori is void of teaching or suggesting that the advertisement of Shambori is printed responsive to the printed number of sheets not being excessive. To the contrary, the analysis of the printed number of pages of paragraph 0073 permits subsequent printing to occur but fails to teach or suggest that printing of the marketing message is initiated responsive to the analysis of paragraph 0073. The selective preventing of printing per paragraph 0073 fails to teach or suggest *initiating communicating of the marketing message using the printer responsive to the detecting the triggering event with respect to a consumable* as positively defined in claim 20.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

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Argument D – The 102 rejection of claim 2 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 1 recites monitoring an association of a consumable with an image forming device. Claim 2 further defines the monitoring of claim 1 and recites that the monitoring of claim 1 comprises *monitoring coupling of the consumable and the image forming device*. Paragraph 0044 of Shambori relied upon by the Office teaches monitoring a remaining amount of consumables. However, the monitoring of the remaining amount of consumables fails to teach monitoring of coupling of the consumable and image forming device. Shambori fails to teach or suggest the claimed monitoring the coupling of the consumable and the image forming device and the rejection of claim 1 is improper for at least this reason.

Appellants refer to examples of paragraphs 0055 and 0056 where it is stated that a variety of operations trigger marketing operations. Per paragraph 0055, coupling (or installation as noted by the Office on page 19 of the Answer) of the consumable is one example which may be used to trigger marketing operations. Per paragraph 0056, additional triggering events may be the status such as remaining capacity of the consumable and which may be used to trigger marketing operations. However, claim 2 clarifies the monitoring of claim 1 and defines that the monitoring of the association is monitoring of the coupling of the consumable with the image forming device distinguished from monitoring of a remaining amount of the consumable. *Appellants' specification makes clear that different triggering events are contemplated (monitoring of coupling of the consumable as distinguished from monitoring of the remaining amount of the consumable).* Claim 2 further defines claim 1 and specifies that the coupling of the consumable and the image forming device is monitored as distinguished from monitoring the status of the consumable as taught in paragraph 0044 of Shambori. The monitoring of the remaining amount of the consumable of Shambori fails to teach monitoring of coupling of the consumable and the image forming device claimed in claim 2.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

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Argument E – The 102 rejection of claim 3 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

In particular, Appellants respectfully submit that the Office has tortured the plain meaning of common terms in order to cure the deficiencies of Shambori with respect to positively recited limitations of the claims and to continue the 102 rejection of claim 3. In particular, claim 3 recites *accessing the marketing message from a memory device of the consumable*. Paragraph 0030 of the specification teaches a memory device 36 of a consumable *where digital data may be written to or read from the memory device* consistent with commonplace understandings of a memory device. Shambori fails to disclose or suggest a consumable including a memory device as is commonly used in the art and as used in Appellant's specification. Positively-recited limitations of claim 3 including *accessing the marketing message from a memory device of the consumable* are not disclosed nor suggested by the prior art and Appellants respectfully request reversal of the rejection for at least this reason.

In addition, claim 3 positively recites accessing the marketing message from *a memory device of the consumable as opposed to claiming that the memory device is the consumable*. If the paper is a consumable as alleged by the Office on page 20 of the Answer, Appellants respectfully submit that the mere presence of the consumable fails to teach accessing the marketing message from a *memory device of the consumable* as explicitly claimed.

Furthermore, claim 3 recites (when properly considered in combination with claim 1), *accessing the marketing message from a memory device of the consumable responsive to the monitoring of the association of the consumable with the image forming device*. The Office at page 20 of the Office identifies the claimed accessing as being disclosed by the act of reading the hard copy or giving the hard copy to someone else to read. However, Shambori fails to teach or suggest the reading or giving the hard copy to someone else responsive to monitoring an association of a consumable with an image forming device as claimed. Appellants respectfully submit that the rejection is improper for this additional reason.

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Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument F – The 102 rejection of claim 4 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 4 recites *accessing an identifier of the marketing message from a memory device of the consumable*. Shambori fails to disclose or suggest any consumables including a memory device as is commonly used in the art and as used in Appellant's specification. Positively-recited limitations of claim 4 are not disclosed nor suggested by the prior art and Appellants respectfully request reversal of the rejection for at least this reason.

Appellants also note that claim 4 further defines the enabling of claim 1 and recites that the *enabling communication of the marketing message to the user comprises accessing the identifier from the memory device of the consumable*. The Office identifies the bar code of paragraph 0042 as allegedly teaching the claimed identifier. However, paragraph 0042 explicitly teaches that the user prints out the advertisement and a bar code which identifies the user may be printed out along with the advertisement. *The printed bar code is read by the shop clerk at the time of purchase and far after communication of the message to the user has already occurred*. The teachings of reading the bar code at the point of purchase after communication of the advertisement may not be fairly considered to teach or suggest the claimed limitations of *enabling communication of the message to the user* comprising accessing the identifier as defined in claim 4. Appellants respectfully submit claim 4 is allowable for at least this reason.

Furthermore, when claim 4 is read in conjunction with claim 1, the claim recites *accessing the identifier responsive to the monitoring of the association of the consumable with the image forming device*. The Office identifies the bar code of Shambori as teaching the claimed identifier and paragraph 0042 teaches that the bar code may be scanned by the shop clerk when the user presents the printed advertisement for purchase. However, the scanning of the bar code at the time of

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purchase fails to teach or suggest accessing the identifier responsive to the monitoring of the association of the consumable with the image forming device as defined by the combined limitations of claims 1 and 4. Appellants respectfully submit that claim 4 is allowable for at least this reason.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument G – The 102 rejection of claim 21 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

In support of the rejection of claim 21, the Office at page 21 of the Examiner's Answer relies upon the teachings of paragraph 0075 of Shambori and states that Shambori discloses monitoring a type of paper installed in an image forming device. However, in contrast to monitoring a type of paper, claim 21 recites (in combination with claim 1) monitoring an association of a consumable with an image forming device and enabling communication of the marketing message to the user responsive to the monitoring detecting the association comprising installation of the consumable within the image forming device. Monitoring a type of paper installed in a printer fails to teach or suggest the claimed limitations of detecting installation of the consumable within the image forming device as recited in the claims. Furthermore, claim 21 recites in combination with claim 1 enabling communication of the marketing message responsive to the monitoring detecting the associating comprising installation of the consumable within the image forming device. The Office has failed to identify any teachings in Shambori of monitoring of installation of a consumable within the image forming device let alone the monitoring detecting installation of the consumable within the image forming device in combination with the claimed *enabling communication of the message to the user responsive to the monitoring detecting the association comprising the installation*. Appellants have electronically searched Shambori and failed to uncover any reference to "installation" let alone monitoring installation or the claimed enabling responsive to the monitoring detecting the installation.

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Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument H – The 102 rejection of claims 12-15 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

During prosecution, the Office originally relied upon the teachings of paragraph 0044 of Shambori in support of the rejection of claim 12. Appellants respectfully submit that paragraph 0044 fails to teach limitations of claim 12 for the reasons set forth in the Brief of Appellants. Now, the Office relies upon the teachings of paragraph 0075 in support of the rejection. The Office states that paragraph 0075 discloses two different triggering events including the type of paper and whether printing has occurred normally. However, as clearly disclosed in paragraph 0075, the process of Fig. 14 (and including the alleged triggering events) *occurs after the printer receives the printing instruction and after the user has already requested to print the advertisement per paragraph 0067. Accordingly, the marketing function of the advertisement has clearly been initiated before the triggering events of paragraph 0075 are performed* which fails to teach or suggest the claimed limitations of *detecting a triggering event with respect to the consumable, and initiating the marketing function responsive to the detecting.* Positively-recited limitations of the claims are not disclosed nor suggested by paragraph 0075 for at least these reasons.

The Office, in the Examiner's Answer, now also relies upon the teachings of the point managing unit 150 of paragraph 0073 of Shambori in support of the rejection. However, paragraph 0073 pertaining to Fig. 13 further defines step S20 of Fig. 12 and is void of teaching initiating the marketing function responsive to the actions of step S20. The Office has identified no teachings that a marketing function of Shambori is initiated responsive to the actions of Fig. 13. Fig. 12 teaches a decrypting/certifying step, issuing points and checking whether the version of encrypted software is the newest which fails to teach or suggest *detecting a triggering event with respect to the consumable, and initiating the*

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marketing function responsive to the detecting. There is no evidence a marketing function is initiated responsive to any operations of Fig. 13 and step S20 of Fig. 12.

Positively-recited limitations of the claims are not disclosed nor suggested by paragraph 0073 for at least these reasons.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument I – The 102 rejection of claim 13 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

At page 22 of the Answer, the Office identifies teachings of paragraph 0042 and the *printing of the advertisement* to the user of Shambori as allegedly teaching the initiating of the marketing function defined in claim 13. However, paragraph 0042 fails to teach initiating comprising communication of a marketing message responsive to detecting a triggering event with respect to a consumable as defined by claim 13 in combination with claim 12.

The Office also relies upon the teachings of paragraph 0082 in support of the rejection. However, paragraph 0082 is directed towards replacement of a consumable and is void of any teaching or reference to the printing of the advertisement relied upon by the Office as teaching the claimed initiating of the marketing function comprising communicating the marketing message. Paragraph 0082 discloses ordering a replacement consumable and provides no teachings that the printing of the advertisement is initiated responsive to the detecting of a triggering event with respect to the consumable. Shambori fails to teach or suggest the claimed limitations of *initiating the marketing function comprising communicating a marketing message responsive to the detecting of the triggering event with respect to the consumable* as positively claimed.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

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Argument J – The 102 rejection of claim 14 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 14 recites that the detecting of the triggering event of claim 12 comprises detecting coupling of the consumable with the image forming device. The present application *distinguishes different operations including operations directed towards installation of a consumable including monitoring coupling of the consumable with the image forming device per paragraphs 0054 and 0055 distinguished from operations of consumable level monitoring per paragraphs 0056 of the specification*. The teachings of Shambori of checking the remaining amount of consumable fails to teach or suggest the limitations of claim 14 reciting detecting the triggering event comprises detecting coupling of the consumable with an image forming device as opposed to the claim reciting detecting the status or remaining amount of the consumable disclosed in paragraph 0056. Further, Shambori fails to teach *initiating a marketing function responsive to the detecting coupling of the consumable with the image forming device*.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument K – The 102 rejection of claim 16 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

At page 23 of the Answer, the Office relies upon the teachings of the printed hard copy as teaching the claimed memory device. Paragraph 0030 of the specification recites an example of a memory device 36 of a consumable where digital data may be written to or read from the memory device. Shambori fails to disclose or suggest a consumable including a memory device as is commonly used in the art and as used in Appellant's specification. Positively-recited limitations of claim 16 including *accessing the marketing message from a memory device of the*

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consumable are not disclosed nor suggested by the prior art and Appellants respectfully request reversal of the rejection for at least this reason.

The Office states that the act of reading the hard copy or giving the hard copy to someone else to read discloses the claimed accessing. However, when claim 16 is properly read in combination with claim 8, the claims recites that *the initiating the marketing function comprises accessing the marketing message from the memory device*. The reading the hard copy message of Shambori occurs after the marketing function of printing the advertisement per paragraph 0041 of Shambori has been initiated. The subsequent acts of reading the already printed advertisement fail to teach the claimed *initiating the marketing function comprises accessing the marketing message*. Appellants respectfully submit that claim 16 is allowable for at least this reason.

As mentioned above, the Office states that the reading of the hard copy teaches the claimed accessing. However, claim 16 recites *communicating the marketing message using the image forming device after the accessing*. Shambori fails to disclose any use of the image forming device for communicating the marketing message after the hard copy is read (identified by the Office as teaching the claimed accessing) which fails to teach the claimed limitations *communicating the marketing message using the image forming device after the accessing*.

Furthermore, the Office relies upon reading the hard copy as teaching the claimed accessing and the Office fails to identify teachings of the claimed limitations of *communicating the marketing message after the accessing*.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument L – The 102 rejection of claim 17 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 17 recites the *consumable comprises a memory device*. Shambori fails to disclose or suggest any consumables including a memory device as is commonly used in the art and as used in Appellant's specification. Positively-recited

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limitations of claim 17 are not disclosed nor suggested by the prior art and Appellants respectfully request reversal of the rejection for at least this reason.

The Office identifies the bar code of paragraph 0075 of Shambori which is printed on the printed advertisement as teaching the claimed identifier. However, the bar code is printed with the advertisement and Shambori fails to teach the claimed limitations of claim 17 reciting that the initiating the marketing function comprises *accessing the identifier*, and further comprising first *communicating the identifier externally of the image forming device to identify the marketing function comprising a marketing message and receiving the marketing message within the image forming device responsive to the first communicating*. Shambori fails to teach any reception of the marketing message within the image forming device responsive to communicating the bar code. To the contrary, Shambori clearly teaches *printing the bar code with the advertisement*. The Answer fails to identify any teaching of *receiving the marketing message within the image forming device responsive to the first communicating of the identifier externally of the image forming device* as explicitly claimed. These limitations of claim 17 are not disclosed nor suggested by the prior art and claim 17 is allowable for at least this reason:

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument M – The 102 rejection of claim 18 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 18 recites *forwarding a marketing message to the image forming device utilizing the external device responsive to the detecting the status of the consumable reaching a predetermined status*. The Office at page 27 of the Answer relies upon the teachings of paragraphs 0041-0042 in support of the rejection. Paragraph 0041 of Shambori provides that the advertisement is provided on the Internet and the user prints out the advertisement. These paragraphs do not support the statement on page 27 of the Answer that “[w]hen the remaining amount is enough the marketing message is communicated to the image forming

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device.” To the contrary of the unsupported allegations of the Office on page 27 of the Answer, Shambori merely teaches that the advertisement is provided on the Internet in accordance with a request from an advertiser. The positively-recited limitations of forwarding a marketing message to the image forming device utilizing the external device responsive to the detecting the status of the consumable reaching a predetermined status are not disclosed by the prior art and Appellants respectfully submit claim 8 is allowable for at least this reason.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument N – The 102 rejection of claim 19 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

The Office in the Office Action made a cursory reliance upon paragraph 0070 in support of the rejection which is improper for the reasons set forth in the Brief of Appellant and as apparently now recognized by the Office in relying upon different teachings of Shambori in the Examiner’s Answer in support of the rejection (which are also deficient with respect to the claimed limitations as discussed below).

In particular, the Office changes its rejection to rely upon paragraph 0013-0015. However, the Office has not identified any support for the allegation that the printing certifying unit and printing managing apparatus are consumed, have fixed life spans or need to be replenished. Shambori is void of any teaching or suggestion that the printing certifying unit or printing managing apparatus are consumed, have fixed life spans or need to be replenished. The unit and apparatus may not be fairly interpreted to teach a consumable and fail to teach or suggest the claimed limitations of offering electrical storage space of a memory device of a consumable as specifically claimed.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

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Argument O – The 102 rejection of claim 22 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

The Office in the Office Action made a cursory reliance upon paragraph 0070 in support of the rejection which is improper for the reasons set forth in the Brief of Appellant and as apparently now recognized by the Office in relying upon different teachings of Shambori the Examiner's Answer in support of the rejection.

The Office has not identified any support for the allegation that the printing certifying unit and printing managing apparatus are consumed or have fixed life spans. The printing certifying unit and printing managing apparatus may not be fairly interpreted to teach a consumable and fail to teach or suggest the claimed limitations of *storing electrical data related to the marketing function using an electrical memory device of the consumable* as specifically claimed.

Furthermore, when claim 22 is properly read in conjunction with claim 8, the claim further recites *providing the consumable usable in the image forming device to form hard images*. There is no evidence that the printing certifying unit or printing managing apparatus are usable in the image forming device to form hard images and the unit and apparatus fail to teach the claimed limitations of providing the consumable.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument P – The 102 rejection of claim 23 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

The Office in the Office Action made a cursory reliance upon paragraph 0070 in support of the rejection which is improper for the reasons set forth in the Brief of Appellant and as apparently now recognized by the Office in relying upon different teachings of Shambori in the Examiner's Answer in support of the rejection.

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The Office has not identified any support for the allegation that the printing certifying unit and printing managing apparatus are consumed, have fixed life spans or need replenishment. The unit and apparatus fail to teach or suggest the claimed limitations of *storing a marketing message in the form of electrical data using an electrical memory device of the consumable* as specifically claimed.

Furthermore, when claim 23 is properly read in conjunction with claim 8, the claim further recites providing the consumable usable in the image forming device to form hard images. There is no evidence that the printing certifying unit or printing managing apparatus are usable in the image forming device to form hard images and the unit and apparatus fail to teach the claimed limitations of providing the consumable.

The Office states on page 30 of the Examiner's Answer that the *marketing message is sitting in a memory device of the printer* which fails to teach or suggest *storing the marketing message using an electrical memory device of the consumable which is usable in the image forming device* (as defined in claims 8 and 23).

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument Q – The 102 rejection of claim 24 over Shambori is improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

The Office has not identified any support for the allegation that the printing certifying unit and printing managing apparatus are consumed, have fixed life spans or need replenishment. The unit and apparatus fail to teach or suggest the claimed limitations of *storing electrical data of the identifier within the memory device comprising an electrical memory device configured to store the electrical data* as specifically claimed.

The Office states on page 31 of the Examiner's Answer that the *marketing message containing the bar code is sitting in a memory device of the printer* which fails to teach or suggest *storing the electrical data of the identifier within the memory device of the consumable* (as defined in claims 17 and 24).

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The Office has failed to identify any teachings of storing the bar code (relied upon by the Office as teaching the claimed Identifier) within the printing certifying unit or printing managing apparatus which are relied upon by the Office as teaching the consumable. The limitations of *storing the electrical data of the identifier within the memory device of the consumable* are not disclosed nor suggested by the prior art.

Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Argument R – The 102 rejection of claim 25 over Shambori is Improper.

Appellants respectfully submit that the 102 rejection is improper for the reasons set forth in the Brief of Appellant. In addition, Appellants respectfully request reversal of the rejections for the reasons set forth herein.

Claim 25 recites that the *initiating communication comprises initiating printing of the marketing message using the printer* and responsive to the detecting the triggering event with respect to the consumable (when claim 25 is read in combination with claim 20 from which it depends). The Office relies upon paragraph 0075 as teaching two triggering events. However, paragraph 0075 discussing Fig. 14 is clear that Fig. 14 is a sequence of the printing operation in step S30 and step S30 is performed after the user indicates a wish to print the advertisement as clearly discussed in paragraph 0067 of Shambori. Accordingly, in Shambori, *communication of the marketing message has already been initiated by the user specifying printing of the advertisement when the operations of paragraph 0075 are performed and which fails to teach or suggest initiating communicating of the marketing message comprising printing of the marketing message responsive to the detecting* as defined in claim 20.

In addition, Shambori is void of teaching or suggesting that the advertisement of Shambori is printed responsive to the an excessive number of sheets not being printed per paragraph 0073 of Shambori. To the contrary, the analysis of the printed number of pages of paragraph 0073 permits subsequent printing to occur but fails to teach or suggest that printing of the advertisement is initiated responsive to the analysis of paragraph 0073.

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Appellants respectfully submit that the limitations of the claims are not disclosed nor suggested by the prior art for the reasons set forth herein as well as the Brief of Appellants. Appellants respectfully request reversal of the rejections.

Conclusion


Reversal of the rejections of the claims and allowance of the claims is respectfully requested for at least the reasons discussed herein and the reasons set forth in the Brief of Appellant.

Respectfully submitted,

Date:

11/13/07

Attorney:


James D. Shaurette
Reg. No. 39,833PDNO. 10006507-1
S/N: 09/932,237
Reply Brief